

REMARKS

A. INTRODUCTION.

Claims 1 through 33 are pending. No claims have been amended or cancelled.

Claims 3, 5 and 18 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Adams et al U.S. Patent No. 6,898,636 issued May 24, 2005 on U. S. Patent Application Ser. No. 09/498,206 which, in turn, refers to U. S. Provisional application No. 60/118,633 filed February 4, 1999. [Hereinafter, "Adams"] See Office Action at 4.

Claims 6, 7, 8, 20, 21 and 22 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Herschkorn USP 6691094.
See Office Action at 5.

Claims 2 and 17 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Levine USP 6233566. See Office Action at 6.

Claims 4 and 19 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Lebda USP 6385594. See Office Action at 7.

Claim 30 has been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Herschkorn USP 6691094. See Office Action at 8.

Claim 31 has been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Herschkorn USP 6691094 and further in view of Lebda USP 6385594. See Office Action at 9.

Claim 32 has been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Herschkorn USP 6691094 and further in view of Lebda USP 6385594. See Office Action at 10.

Claim 33 has been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Adams in view of Herschkorn USP 6691094 and further in view of Lebda USP 6385594. See Office Action at 11.

**B. THE REJECTIONS SHOULD BE WITHDRAWN IN VIEW OF THE HEREWITH
SUBMITTED DECLARATION OF THE INVENTOR PURSUANT TO 37 C. F. R. § 131.**

Applicant respectfully submits that Adams should be withdrawn as a reference, based on the accompanying Declaration of Edmund H. Louie under 37 C.F.R. § 1.131 and that all rejections should be withdrawn for failure to form a prima facie case of obviousness.

1. CLAIM REJECTIONS PURSUANT TO 37 C. F. R. § 103

In the Office Action, all original claims 1-33 were rejected under 35 U. S. C. § 103. The rejection of all claims was based upon a single primary reference, Adams et al U.S. Patent No. 6,898,636 issued May 24, 2005 on U. S. Patent Application Ser. No. 09/498,206 which, in turn, refers to U. S. Provisional application No. 60/118,633 filed February 4, 1999. ["Adams"]

**2. THE INVENTOR SWEARS BEHIND THE ADAMS REFERENCE PURSUANT
TO 37 C. F. R. 1.131**

Pursuant to the attached Declaration of Inventor Edmund H. Louie under 37 C.F.R. § 1.131, Applicant hereby swears behind the Adams reference in that the inventor actually reduced the invention to practice before the earliest possible effective date of Adams, namely the filing date of U. S. Provisional application No. 60/118,633 filed February 4, 1999.

Since the Adams reference is not a valid reference, Applicant respectfully submits that all rejections should be withdrawn because the remaining references do not disclose each and every element of the pending claims and therefore do not form a prima facie case of obviousness.

Specifically, as described in the attached Louie Rule 131 Declaration and exhibits, the present invention was actually reduced his invention to practice by July 20, 1998 which, of course, was well prior to the February 4, 1999 earliest possible effective date of Adams. (See, e. g., Louie Declaration ¶ 11.)

In his Declaration and exhibits, Mr. Louie has provided very detailed and documented proof of his actual reduction to practice well prior to the effective date of Adams. See, for example, paragraph 13:

"13. The new Agent Plus program worked essentially flawlessly from the initial tests. The new Agent Plus system was successfully tested using code I wrote at least as early as December 1997. I had the code working well enough to start experiments with our invention at least as early as July 1998 on JPMC computers. I was able to run the program in a fully workable manner, i.e., to

actual reduction to practice, from that time on. To show this, I am attaching the following Exhibits and attendant explanation of events.

- Exhibit 1 is detailed project plan of the Agent Plus Replatforming Project from inception to implementation. I affirm that all actual start and end dates appearing in columns E and F of Exhibit 1 are accurate. This project plan was last modified on June 28, 1999.
 - o Row 217 records the date that software development on the project started – December 8, 1997.
 - o Row 294 records the date that initial testing of the new application started – July 20, 1998.
 - o Row 307 records the date that user acceptance testing of the new application started – November 5, 1998.
- Exhibit 2 is a detailed test script for Pre-User Acceptance testing of the replatformed Agent Plus that was conducted in July of 1998. This script document was last revised on July 22, 1998.
- Exhibit 3 is the User Acceptance Test Schedule that was held from November 5 through November 20, 1998. This schedule was last revised on October 21, 1998.
- Exhibit 4 is an official memo from the General Audit Department dated May 25, 1999 giving the approval to implement the Agent Plus Replatforming Project into Production.
- All exhibits were retrieved from network drives of JPMC computers located at 1 Chase Manhattan Plaza.”

SUMMARY

In short, the Louie Declaration clearly demonstrates, with dated exhibits, that the present invention was actually reduced to practice at least July 20, 1998.

Since that date of actual reduction to practice is well before the earliest possible effective date of the Adams reference of February 4, 1999, per 37 C. F. R. § 1.131 and MPEP § 715.07 (III) (A), the attached Declaration of Mr. Louie has successfully provided voluminous facts sufficient to remove the Adams reference. Accordingly, the Adams reference is no longer a valid reference to be cited against the Application.

3. THE REMAINING SECONDARY REFERENCES DO NOT FORM A PRIMA FACIE CASE OF OBVIOUSNESS UNDER 35 U. S. C. § 103.

In view of the removal of the primary reference, Adams, the remaining references do not disclose the elements allegedly disclosed by Adams. Even in combination, the remaining references do not disclose each and every element of original pending claims 1 through 33 and therefore do not form a prima facie case of obviousness.

Accordingly, there is no legal basis for a rejection under 35 U.S.C. § 103 and Applicant respectfully submits that the rejection should be withdrawn.

CONCLUSION

Applicant respectfully submits that claims 1 through 33 are in condition for allowance and requests allowance of the same.


In the event the PTO determines that any fees are due in connection with this matter, Applicant requests that such fees be deducted from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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